

INTERVIEW SUMMARY

The undersigned attorney appreciates Examiner Nguyen's time in a telephonic interview regarding this application conducted on August 14, 2008. In the interview, the prior art status of U.S. Patent No. 6,500,182 to Foster ("Foster") was discussed. Specifically, the applicability of 35 U.S.C. §103(c) to this application was discussed. The Examiner asserted that Foster was prior art under both 35 U.S.C. §§ 102(a) and 102(e) and therefore 35 U.S.C. § 103(c) was inapplicable based on the evidence currently of record in the application.

REMARKS

Claims 1, 2, 5-8, 10, 11, 13-17, 20-22, 25, and 26 are pending and are rejected. Claims 9, 23, and 27-29 are withdrawn pursuant to a previous restriction requirement. In view of the *Statement of Prior Invention under 37 C.F.R. § 1.131* and the arguments filed with this Response, Applicants submit that the pending claim rejections are improper for a failure to provide a *prima facie* case of obviousness. Applicants accordingly request that the rejections currently of record be withdrawn.

The pending claims 1, 2, 5-8, 10, 11, 13-17, 20-22, 25, and 26 are each rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 6,500,182 to Foster ("the '182 Foster patent") in view of U.S. Patent No. 5,843,050 to Jones ("Jones"). Applicants respectfully traverse.

A. The '182 Foster Patent Is Not 35 U.S.C. § 102(a) Prior Art

As discussed in detail below, Applicants submit herewith a paper titled *Statement of Prior Invention under 37 C.F.R. § 1.131* that provides a statement from each of the inventors of record that the disclosed and claimed subject matter was invented prior to November 15, 2001, which is the date of initial publication of the application (09/277,098) that matured into the '182 Foster patent. The Statement of Prior Invention includes both a declaration signed by each inventor of record (Thomas L. Foster and Frederick D. Roemer) asserting invention prior to November 15, 2001 and provides documentary evidence that the disclosed and claimed subject matter was

invented prior to November 15, 2001. The documentary evidence includes four pages of drawings and a fax cover sheet, each dated prior to November 15, 2001 that provide evidence of prior invention of the subject matter disclosed and claimed in the subject application prior to November 15, 2001.

This statement and the drawings show that the inventors invented a flexible cannula by making spiral cuts along a longitudinal axis of the cannula prior to November 15, 2001. The drawings by themselves are sufficient to show reduction to practice as they include sufficient details (dimensions, materials, surface finish, etc.) to have allowed a physical specimen to have been made directly and only from the drawings. The documents also show at least reasonable diligence by the fact that the inventors' sketches were reduced to drawings with preferred sizes and dimensions for manufacturing flexible cannula prototypes. The provisional application (60/395,280) from which the present application claims priority was filed on July 12, 2002. Accordingly, Foster is not prior art to the subject application under 35 U.S.C. § 102(a) because the inventors of record invented the disclosed and claimed subject matter prior to the initial publication of the '182 Foster patent.

B. 35 U.S.C. § 103(c) Prevents The '182 Foster Patent From Being Included In An Obviousness Rejection

Because the '182 Foster patent is not 35 U.S.C. § 102(a) prior art to the subject application, the '182 Foster patent may only be considered to be prior art under 35 U.S.C. § 102(e). As discussed above, the application that matured into the '182 Foster patent was initially published on November 15, 2001 (U.S. Published Application No. 2001/0041899). Because the current application claims priority from a provisional application filed on July 12, 2002, the '182 Foster Patent is not prior art under 35 U.S.C. § 102(b). Additionally, the inventors of record of the subject application were under an obligation to assign the invention and this application that matured from the invention to Vance Products Inc. d/b/a Cook Urological Inc. at the time the invention was made by virtue of their terms of employment with Cook Urological Inc. and the fact that the invention was made during their normal course of employment with Cook

Urological Inc. (See Statement of Prior Invention, paragraphs 2 and 4). Cook Urological Inc. is the assignee of record of the '182 Foster patent, as recorded with the USPTO. The subject application was formally assigned to Vance Products Inc. d/b/a Cook Urological Inc. on July 16, 2003 by each inventor of record, which was subsequently recorded with the UPSTO. Because the '182 Foster patent is only eligible as prior art to the subject application under 35 U.S.C. § 102(e) and the inventors were under a preexisting obligation to assign the invention to Cook Urological Inc. when the disclosed and claimed subject matter was invented, the '182 Foster patent is not eligible to be asserted against the subject patent application in an obviousness rejection. See 35 U.S.C. § 103(c)(1).

Accordingly, Applicants submit that a *prima facie* case of obviousness does not exist, because the only cited prior art available for an obviousness rejection is Jones. The deficiencies of Jones vis-à-vis the pending claims of this application are fully documented in the Amendment filed by Applicants on April 10, 2008, which was filed in response to an office action dated December 14, 2007. For at least the reasons provided in the April 10, 2008 Amendment, Jones does not render obvious, much less anticipate, the pending claims of the subject application. Accordingly, Applicants respectfully request that the current rejection be withdrawn.

The pending claims are patentable. Applicants request expedited allowance of this application. The Examiner is invited to contact the undersigned attorney at (312) 222-8124 if doing so would expedite prosecution of this application.

Respectfully submitted,

/Stephen C. Smith/
Stephen C. Smith
Registration No. 56,250
Attorney for Applicants

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200